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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,383	06/26/2001	lan A. Cody	JHT-0104	2888
75	90 01/28/2003			
James H. Takemoto			EXAMINER	
ExxonMobil Research and Engineering Company P.O. Box 900			NGUYEN, TAM M	
Annandale, NJ 08801-0900			ART UNIT	PAPER NUMBER
			1764	6
			DATE MAILED: 01/28/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

•	Application No.	Applicant(s)				
	09/892,383	CODY ET AL.				
Office Action Summary	Examiner	Art Unit				
	Tam M. Nguyen	1764				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a rep - If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statut - Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b). Status	136(a). In no event, however, may a reply by within the statutory minimum of thirty (30) will apply and will expire SIX (6) MONTHS to cause the application to become ABANDO	ne timely filed I days will be considered timely. If on the mailing date of this communication. DNED (35 U.S.C. § 133).				
1) Responsive to communication(s) filed on 26	<u>June 2001</u> .					
2a) ☐ This action is FINAL . 2b) ☑ TI	his action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4) Claim(s) 1-26 is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1-26</u> is/are rejected. 7)□ Claim(s) is/are objected to.						
8) Claim(s) is/are objected to.						
Application Papers						
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11) The proposed drawing correction filed on is: a) □ approved b) □ disapproved by the Examiner.						
If approved, corrected drawings are required in reply to this Office action.						
12) The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) All b) Some * c) None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).						
a) ☐ The translation of the foreign language provisional application has been received. 15)☑ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.						
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) §	5) Notice of Inform	mary (PTO-413) Paper No(s) nal Patent Application (PTO-152)				

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,911,874 in view of Sequeira (5,039,399).

The U.S. Patent claimed process is drawn to a process for producing a lubricating oil which is similar to the present claimed process. The claimed process of the U.S. Patent does not disclose a water content in the solvent ranging from 3 to 10 vol. %. However, the Sequeira reference discloses a process for removing aromatics from a lubricating oil by using a solvent which comprises 3 to 10 vol. % of water (see col. 5, lines 9-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claimed process of the U.S. Patent by using the Sequeira solvent because the solvent is effective for removing aromatics from a lubricating oil feed.

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Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,976,353 in view of Sequeira (5,039,399).

The U.S. Patent claimed process is drawn to a process for producing a lubricating oil which is similar to the present claimed process. The claimed process of the U.S. Patent does not disclose a water content in the solvent ranging from 3 to 10 vol. %. However, the Sequeira reference discloses a process for removing aromatics from a lubricating oil by using a solvent which comprises 3 to 10 vol. % of water (see col. 5, lines 9-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claimed process of the U.S. Patent by using the Sequeira solvent because the solvent is effective for removing aromatics from a lubricating oil feed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the hydroconverted raffinate" in line 1 of step (d). There is insufficient antecedent basis for this limitation in the claim. It is unclear if the limitation is the same as "the first hydroconverted raffinate" in the last line of step (c) of claim 1.

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The expression "a VI less than about 120" in lines 3-4 of step (c) of claim 25 renders the

claim indefinite because the word "about" in the expression includes a VI greater than 120.

Appropriate correction is required.

Claim 26 recites the limitation "the hydroconverted raffinate" in line 1 of step (d). There

is insufficient antecedent basis for this limitation in the claim. It is unclear if the limitation is the

same as "the first hydroconverted raffinate" in the last line of step (c) of claim 26.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 305-5408 for regular

communications and (703) 305-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam M. Nguyen

Examiner

Art Unit 1764

Tam Nguyen/TN January 24, 2003

Walter D. Griffin

Primary Examiner